



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/698,341 | 10/27/2000 | Joseph A. Sorge | 25436/1560 | 6038 |
| 27495 | 7590 | 05/14/2004 | EXAMINER | |
| PALMER & DODGE, LLP KATHLEEN M. WILLIAMS / STR 111 HUNTINGTON AVENUE BOSTON, MA 02199 | | | HUTSON, RICHARD G | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1652 | |

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/698,341

Applicant(s)

SORGE ET AL.

Examiner

Richard G Hutson

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 12 April 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1,5,108,109,115-121,126 and 127.

Claim(s) objected to: 111 and 112.

Claim(s) rejected: 89-107,110,113,114 and 122-125.

Claim(s) withdrawn from consideration: 48-84.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____



Richard G Hutson, Ph.D.
Primary Examiner
Art Unit: 1652

Continuation of 2. NOTE: Applicants proposed amendment is acknowledged however will not be entered for the following: Applicants proposed amendment of claim 111 will not be entered because it raises a new issue that has not previously been considered and/or searched. Specifically claim 111 was drawn to the isolated recombinant JDF-3 DNA polymerase of claim 110, wherein said mutation at one or more amino acids is at L408 or P410 within Region II. Now applicants have proposed amending the claim such that it is now drawn to the isolated recombinant JDF-3 DNA polymerase of claims 108 or 109 further comprising a mutation at L408 and/or P410. At the very least the proposed limitation that the claimed DNA polymerase may have a mutation at L408 and P410 is a new issue after-final.

Further applicants proposed amendment of claim 112 to depend from claims 108 or 109 and stipulate that "said mutation at L408" and "said mutation at P410" raises the issue of antecedent basis as claims 108 and 109 do not have the recited mutations.

Further proposed newly added claims 128-130 are drawn to a genus of mutant DNA polymerases not yet currently examined, i.e. those mutant JDF-3 DNA polymerases of claim 117 "further comprising both mutations P410L and A485T" or both mutations D141A and E143A".

Applicants attention is further drawn to claims 89-107 and 110, which applicants state they have withdrawn. It is unclear by what mechanism applicants have "withdrawn" claims 89-107 and 110. If it is applicants intent to cancel these claims without prejudice to their pursuance in a continuing application then it is suggested that they do so. Until such time these claims remain active and rejected/objected to for the reasons made of record.

Continuation of 3. Applicant's reply has overcome the following rejection(s): . Applicant's reply has overcome the following rejection(s): Applicants reply has overcome the previous objection to the specification based on the sequences listed in figures 14 and 15. .

Continuation of 5. does NOT place the application in condition for allowance because: the rejections of record remain in light of the non-entry of applicants proposed amendment and as discussed above applicants attention is drawn to those comments regarding "applicants withdrawal" of claims 89-107 and 110..